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No. 00-249

In The
Supreme Court of the United States

ATLANTIC RICHFIELD COMPANY, CHEVRON U.S.A., INC., EXXON MOBIL CORPORATION, MOBIL OIL CORPORATION, SHELL OIL PRODUCTS COMPANY, and TEXACO REFINING AND MARKETING, INC.,

Petitioners,

v.

UNION OIL COMPANY OF CALIFORNIA,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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RESPONDENT'S BRIEF IN OPPOSITION

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QUESTIONS PRESENTED FOR REVIEW

1. Whether the extensive description in the application resulting in United States Patent No. 5,288,393, which recites several key characteristics of gasoline and the directions in which to vary those characteristics within certain ranges to produce less polluting exhaust emissions from automobiles, provided adequate support for the gasoline compositions claimed in the patent by defined ranges of the described characteristics.

2. Whether the court of appeals, in agreement with the district court, correctly construed the patent claims, thus establishing the novelty of the claimed compositions.

RESPONDENT'S RULE 29.6 DISCLOSURE

Respondent is a wholly owned subsidiary of the Unocal Corporation.

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OPINIONS BELOW

Petitioners omit mention of several opinions of the district court, including two that are reported. One decision rejected the Petitioners' contentions that Respondent Union Oil Company of California ("Unocal") committed inequitable conduct in prosecuting its application in the PTO. 34 F. Supp. 2d 1208. The second awarded Unocal attorney fees for petitioners' conduct of this litigation, including their assertion that Unocal derived its invention from an industry group and was equitably estopped from asserting infringement based on alleged lulling of the industry group into believing that Unocal would not enforce its patent rights. 34 F. Supp. 2d 1222.

STATEMENT

A. Background

In 1989, the automobile and oil industries launched a joint research program to learn how motor gasoline might be "reformulated" to reduce the harmful pollution from the exhaust emissions of millions of automobiles throughout the Nation, and, more particularly, in California. Petitioners as well as Unocal were part of this Auto/Oil group. The participants expressly agreed, when joining the program, to preserve their intellectual-property rights in the results of their own continuing individual research and development activities. Trial Transcript 1130-37.

When the Auto/Oil group proposed what characteristics of motor gasoline to study, Unocal's Drs. Jessup and Croudace concluded that the group's narrow focus on only four gasoline properties was not based on sound scientific considerations. They proposed that the group should analyze additional characteristics. The group rejected the proposal. Ct. App. JA 5008-27.

Drs. Jessup and Croudace pressed ahead with this broader experimentation concept on their own, using Unocal's research facilities and Unocal funding. *Id.* Their experiments studied ten gasoline properties for their emission effects, in contrast to the Auto/Oil group's study of only four properties. *Id.* at 5028-33. By March 30, 1990, they had determined that several properties could be carefully adjusted in certain directions in relation to each other (raising one, lowering another) to reduce automobile-exhaust emissions of targeted pollutants. *Id.* at 5037-39, 5042-44, 5060. These included T50, the Reid Vapor Pressure (RVP), T10, T90, olefin content, paraffin content, and octane. *See* Pet. App. 4a (explaining these properties).

Unocal, as assignee of the patent rights, filed a patent application for the invented cleaner gasoline compositions on December 13, 1990. *See* Ct. App. JA 447 (U.S. Patent No. 5,288,393, the '393 patent). Citing the problem of pollution from "the great number of automobiles," the extensive patent specification (18 columns in addition to the claims) describes pollution-reducing gasoline fuels that refiners can produce by "blending a plurality of hydrocarbon-containing streams," using the "knowledge of which properties of a gasoline fuel to alter, and in which direction (i.e., increased or decreased)," as taught in the patent. '393 Patent col. 1, lines 15, 49-50, 42-44; *see* Pet. App. 2a-3a (describing mixing of petroleum stocks to alter

key properties). Over the next three years, "[a]s is often the case during the course of prosecution, the inventor added and canceled many claims." Pet. App. 2a. The patent ultimately issued on February 22, 1994, with 155 claims – which Unocal ultimately reduced to 41 claims (by disclaiming the remainder). *Id.*

Specific motor gasoline compositions, with characteristics defined by specified numerical ranges of the T50, RVP, and other properties, are claimed as inventions in these claims. Each claim begins with a preamble claiming "[a]n unleaded gasoline fuel, suitable for combustion in an automotive engine" or "in a spark ignition automotive engine." '393 Patent cols. 18-26; *see* Pet. App. 2a-3a. The compositions are then further defined in the claims not by specific molecular makeup but by the controlled combination of characteristics such as T50 and RVP, as well as other chemical properties, "reflecting the way oil refiners formulate gasoline." Because "oil refiners of ordinary skill in the art change the chemical properties of gasoline by varying the proportions of different petroleum stocks, . . . the claims which define the invention in terms of various characteristics [T50, RVP, etc.] also inform those of skill in the art of the composition of the claimed gasoline fuels." Pet. App. 3a.

In November 1991, nearly a year after the patent application was filed, the California Air Resources Board (CARB), a state regulatory agency, announced new regulations specifying certain properties to be required of gasolines sold in California for use in automobiles. In arriving at its regulations, CARB had not conducted studies of its own, but relied on the industry to provide the needed research and resulting knowledge. Ct. App. JA 5108-18. As of March 1990 –

Unocal's invention date – CARB had decided to regulate only RVP, benzene, and detergent content. *Id.* at 5119-29. By the time of the December 1990 patent application, CARB was unaware of any study examining all the variables studied by Unocal. *Id.* at 5133-34. In June 1991, CARB officials met with Drs. Jessup and Croudace, who disclosed their research data and urged CARB to fashion their regulations in a way that allowed refiners flexibility in how to reach the desired results. *Id.* at 5145-49. A few months after the November 1991 release of the CARB regulations, Unocal brought the regulations to the attention of the PTO examiner and asked her to compare them with the pending application. *Id.* at 5064-68, 5776-82. Only thereafter was the patent granted.

The CARB regulations did not apply to gasoline sales until early 1996. Pet. 5. During the intervening two-year period after the '393 patent issued in February 1994, CARB made no alteration to its requirements to try to minimize or eliminate refiners' likelihood of infringing the '393 patent by complying with the regulations. Nor did CARB seek to pay for the invention of cleaner fuels that helped the state agency fulfill its mission of securing widespread environmental benefits for the public by reducing pollution from the millions of cars in California.

B. District Court Proceedings

Petitioners sued Unocal for a declaratory judgment of patent invalidity in April 1995, and Unocal counterclaimed for infringement. (In the absence of an enforcement threat by Unocal, the declaratory-judgment claim was improper, so it was "effectively convert[ed]" into a defense to Unocal's infringement claim. Pet. App. 7a.) Before trial, the district court (now-

Circuit Judge Kim McLane Wardlaw) construed the claims at issue. The court held, in particular, that the common preamble phrase (which, it is now undisputed, constitutes a limitation on the patent claims) requires a standard automotive gasoline, not aviation or specialty racing fuels. Pet. App. 32a-47a.

Trial was then had to a jury as to the factual issues underlying the determination of the patent's validity. Specifically, as relevant here, the jury tried whether certain gasoline compositions in the art prior to the 1990 invention date matched the claimed gasoline compositions and thus rendered the claimed compositions not novel ("anticipated"), 35 U.S.C. § 102, and whether the claims were sufficiently supported by the original application (the specification, plus the original claims) to show that the inventors were in possession of the claimed gasoline compositions at that time, thereby satisfying the "written description" requirement under 35 U.S.C. § 112, ¶ 1. After 49 days of trial, the jury deliberated for 13 days and, in answering 223 special-verdict questions, held that Unocal's patent was valid, rejecting petitioners' anticipation and written-description challenges. Pet. App. 7a-8a. The California citizen jury also found infringement and, upon hearing damages evidence, found a royalty rate of 5.75 cents per gallon to be appropriate and awarded $69 million (plus interest) in damages for the period ending July 1996. Pet. 5.

The district court denied petitioners' post-trial motions on the validity issues. Pet. App. 48a-56a. In addition, the district court separately tried, and rejected, petitioners' contention that Unocal committed inequitable conduct in prosecuting the application before the PTO. 34 F. Supp. 2d 1208, 1222; *see* Pet. App. 8a. The district court also awarded Unocal attorney

fees under 35 U.S.C. § 285, citing "the manner and method by which [petitioners] asserted, litigated and ultimately abandoned [certain] claims," including equitable estoppel and assertions that Unocal "derived" its invention from CARB and sandbagged the Auto/Oil group working toward the regulations, as well as the "personal and destructive nature" of petitioners' litigation allegations, "vexatious conduct" and the "unsupported" nature of several contentions. 34 F. Supp. 2d 1222, 1224 -25.

C. The Court of Appeals Decision

On appeal, petitioners presented three contentions: *first*, that the patent claims had been improperly construed so as to embrace only standard automotive gasolines (the basis for finding novelty), Ct. App. Corrected Brief for Defendants-Appellants at 15-35; *second*, that the issued claims were "unsupported by the original application" and thus flunked the ordinary standards of the written-description requirement, *id.* at 36-49; *third*, that there was inequitable conduct before the PTO, *id.* at 50-66. Although petitioners presented the regulatory context for atmospherics, they made no contention that the CARB regulations trumped, or required bending of, the ordinary principles of patent validity, including the adequate-support standards of the written-description requirement. The court of appeals rejected all three of petitioners' contentions and affirmed the district court. Pet. App. 1a-24a.

The court first affirmed the district court's construction of the patent claims' preamble language, read in the context of the entire patent (including its description of the problem being solved), as embracing only standard automotive fuels. Pet.

App. 9a-12a. That construction settled the anticipation issue, as the jury found. Petitioners, to show anticipation (lack of novelty under Section 102), had identified only certain aviation and racing gasolines as prior art supposedly containing all the limitations of the patent claims. The court of appeals readily noted petitioners' own evidence and admissions that such fuels were not the same chemical compositions as standard automotive fuels. Pet. App. 12a.[1]

The court of appeals next concluded that the jury could reasonably find that Unocal's patent application, including the written description and original claims, contained adequate information to support the claims as issued. Pet. App. 13a-22a. The court recited that an inventor's application must "'allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed,'" *i.e.*, the inventor must have "conveyed with reasonable clarity to those of skill in the art that he was in possession of the subject matter of the claims." Pet. App. 13a. Applying those standards, the court noted that, in

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[1] Racing gasoline, in particular, requires very high octane levels, necessitating use of pure compounds produced in chemical plants. Ct. App. JA 5005-07, 5189-96, 5186, 5293-95, 5208A-5208B. Petitioners' experts acknowledged that the compositions of racing gasoline and motor gasoline (the latter the term for standard gasoline) are very different. *Id.* at 5314, 5361-67, 5371. A letter from petitioner Chevron's in-house gasoline expert told state authorities that "racing gasoline . . . is not considered motor gasoline." *Id.* at 6070. A PTO submission by petitioner Atlantic Richfield notes that "motor vehicle gasoline . . . is thus not a highly purified chemical, nor mix of highly purified petrochemicals." *Id.* at 6024.

this particular art, it simply was not necessary for the molecular, chemical makeup of the compositions to be identified for those skilled in the art to see that the inventors possessed particular compositions, because the refiners' art allowed such identification by T50, RVP, and other properties, with teachings about the direction of adjustment of these properties to produce particular compositions:

> The patent unmistakably informs skilled refiners to increase or decrease the various components to arrive at preferred combinations. In fact, the written description usually labels both preferred and most preferred levels within each range. Skilled refiners testified that they knew the composition of the claimed combinations based on this written description. . . . In sum, the record shows that the inventors possessed the claimed invention at the time of filing in the assessment of those of ordinary skill in the petroleum refining art.

Pet. App. 18a (footnote omitted). Stressing that "written description questions are intensely factual," the Federal Circuit carefully reviewed and distinguished *In re Ruschig*, 379 F.2d 990 (CCPA 1967), on that and other grounds (citing *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985)). Pet. App. 21a-22a. Whereas *Ruschig* had found inadequate support for a claim to a single compound copied from another's patent in the applicant's disclosure of a broad class of compounds in the pharmaceutical field, the present patent does not claim a single compound and the relevant prior art is different: "Artisans skilled in petroleum refining, in contrast, are aware of the properties of raw petroleum sources and know how to mix streams of such sources to achieve a final product with desired characteristics." Pet. App. 21a. In this

field, teaching the desired combination of characteristics defined the compositions to those of skill in the art. *Id.* Accordingly, there was substantial evidence to support the jury's finding of adequate support.[2]

Judge Lourie dissented on the application of the written-description requirement in this case. Pet. App. 24a-31a. He noted that the requirement was inevitably case-specific (*id.* at 26a), and he did not disagree with the above-quoted standards for satisfaction of the requirement. He merely disagreed with the majority in its holding that a jury could reasonably find adequate support for the claims in the disclosure of the '393 patent, including its description of the directions in which the T50, RVP, and other properties could be adjusted to arrive at the targeted reductions of harmful emissions. *Id.* at 24a-31a. Judge Lourie did not cite any regulation-based ground for his conclusion.

Petitioners sought both panel and *en banc* rehearings. Both requests were denied. Neither Judge Lourie nor any other judge on the Federal Circuit voted for rehearing. Pet. App. 57a.

REASONS FOR DENYING THE PETITION

Petitioners have presented no question meriting this Court's review. The Federal Circuit's decision does not announce any principle of law in conflict with any decision of this Court, of

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[2] The court also rejected petitioners' inequitable-conduct contention (Pet. App.22a-23a), which they do not renew in this Court.

another court of appeals, or of the Federal Circuit itself (or its predecessor courts) – as indicated by the failure of any judge, including the dissenting member of the panel, to vote for en banc review. Presenting pure (non-constitutional) patent-law issues within the special expertise of the Federal Circuit, this case involves no disputed general propositions of patent law, let alone fundamental ones, and still less any issues that have generated a persisting cacophony of views within the Federal Circuit. The decision below addresses a highly fact-specific application of uncontested legal principles to one particular set of patent claims and disclosures. Even in dissenting on the written-description issue, Judge Lourie himself made clear the case-specific nature of the dispute. Pet. App. 26a, 30a. On both the written-description and claim-construction issues, moreover, the Federal Circuit's application of settled principles in this case was correct.

In their effort to justify review, petitioners pervasively stress the similarity of the patent to California-law regulatory requirements for less polluting gasoline. But petitioners simply cannot transform that general theme into a properly preserved and certworthy legal question, most obviously because no version of the contention that state-law regulatory requirements somehow dominate patent rights was either presented to or decided by the Federal Circuit. Without any general legal ruling for this Court to review, the fact that the patent at issue has significant commercial value (commensurate with the

environmental benefits it confers) is not a ground for review.[3] The petition accordingly should be denied.

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[3] The only thing presently known about the commercial value of the patent is the damage award for the tried period of infringement with no efforts made in that period to blend gasolines that might be outside the patent. Even a larger award – based on 29% of the summer gasoline sold infringing, and a royalty of 7 cents a gallon – works out to less than $11 per year for an individual driving 15,000 miles per year and getting 18 miles per gallon. Ct. App. JA5375-80.

Petitioners have little other basis for touting the cost import of the patent. A single sentence in recent congressional testimony by the FTC Chairman about the potential causes of the recent rise in gasoline prices in the Midwest (quoted at Pet. 9-10), amid lengthy discussions of numerous factors, says that the patent's validity "'*may* have caused'" some refiners to attempt to design gasolines outside the patent and thus delayed or reduced some refinery output. (Emphasis added.) In contrast, the Congressional Research Service recently concluded that "any license fee owed to Unocal once the license fee is ultimately determined would be too small to create a barrier to making [reformulated gasoline]." June 16, 2000 Congressional Research Service Memorandum, p. CRS-2. Unocal has openly offered to license the patent to all refiners, blenders and importers of gasoline since April of 1995. 34 F. Supp. 2d at 1224.

A. The Lower Courts' Upholding of the Jury's Finding of Adequate Written Description Does Not Merit Review

Though petitioners have written a single complex question mentioning the written-description requirement, the awkward drafting of the question itself betrays the distinct nature of the issues it presents. Petitioners' central contention is that the patent claims' resemblance to state-law regulatory requirements should erase Unocal's patent rights even if the patent claims meet all other requirements, including the normal standards for adequate support in the original disclosure. Pet. 11-16. That contention is wholly different from, and cannot fairly be shoehorned into, the issue whether the disclosures in the original patent application were sufficient to show that the inventors were in possession of the inventions set forth in the claims of the patent as later issued.

Petitioners strain to merge the issues for the simple reason that their regulatory-trumping, regulatory-gaming contention was not raised in the Federal Circuit. This Court has repeatedly rejected efforts to raise issues not presented or decided below. *Davis v. United States*, 495 U.S. 472, 489 (1990); *Schall v. Martin*, 467 U.S. 253, 261 n.11 (1984). As previously noted, petitioners did not argue that CARB requirements defeated otherwise-valid patent rights in the court of appeals, whether as an independent legal limit on patent rights or, illogically, as an additional new test for satisfaction of the written-description requirement (which has nothing to do with regulation). Petitioners did attempt some form of regulatory-gaming argument *in the district court*, through "equitable estoppel" and "derivation" contentions, but they were charged with attorney fees for pressing those unsupported contentions, and they did

not pursue any such contention in the court of appeals.[4] Not surprisingly, then, there is no Federal Circuit ruling on any issue of regulatory trumping for this Court to review. Petitioners' failure to raise the issue and the absence of any court of appeals pronouncement to review are doubly sufficient to deny review of petitioners'contention.

The regulatory-trump contention in this case also plainly lacks merit. It finds no support in written-description precedent because such regulatory concerns have nothing to do with that requirement, which simply demands that claims added by amendment in the PTO have adequate support in the application as filed (so as to be entitled to the filing date of that application for purposes of determining what is "prior" art). And the notion of a free-standing limit on otherwise-valid patent rights – for which petitioners latch onto the Second Circuit's recent decision in *SmithKline Beecham Consumer Healthcare, L.P. v. Watson Pharmaceuticals, Inc.*, 211 F.3d 21 (2d Cir. 2000), petition for cert. filed (June 3, 2000) (No. 00-19) – has no application here. *SmithKline* held that one federal statute (the generic-drug-encouraging amendments to the Food

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[4] We note that petitioners did not object to the following legally correct jury instruction: "It is not improper to amend or insert claims into a patent after the application has been filed, even if those claims are intended to cover a competitor's product about which the applicant learned during the prosecution of the application, provided that the amended or inserted claims are supported by the written description in the original patent specification." Court's Instruction No. 27, JA6198; *see Kingsdown Medical Consultants Ltd. v. Hollister Inc.*, 863 F.2d 867, 874 (Fed. Cir. 1988).

Drug & Cosmetics Act) limited certain (not very central) rights under another federal statute (the Copyright Act), reaching such a conclusion out of necessity because there was a "conflict between two statutes" at the federal level. *Id.* at 27. The premise for undertaking the effort to resolve that statutory conflict, however, simply does not exist in this case, which involves no conflict of the federal patent law with any other federal statute at all. California regulations cannot trump federal patent rights, and nothing in the Federal Circuit's decision repudiates the Second Circuit's general analysis in *SmithKline* where a statutory conflict does exist. Indeed, *SmithKline* relied on the Federal Circuit's decision in *Zenith Elecs. Corp. v. Exzec., Inc.*, 182 F.3d 1340, 1347 (Fed. Cir. 1999), for that analysis. *SmithKline,* 211 F.3d at 28.

With no basis to support review of their regulation-based contention, petitioners have nothing left but a brief argument that the panel mistakenly concluded that the jury could reasonably find ordinary written-description requirements satisfied. Pet. 16-18. This argument, the one petitioners did present to the Federal Circuit, raises no issue warranting this Court's review. All three judges recognized the fact-specific nature of the inquiry. There was no dispute about the general standards, only how they should be applied here. And the Federal Circuit amply explained why the jury in this case could reasonably find the extensive disclosure of the '393 application adequate to support the issued claims, judged from the necessary perspective of skilled refiners. Pet. App. 13a-22a.

Petitioners, challenging this holding, do not press the particular point emphasized by Judge Lourie: that the original disclosure should have described each specific combination of each issued claim's limitations. Instead, petitioners, citing the

'393 application's disclosure of a large number of possible compositions (based on varying the T50, RVP, and other properties), suggest that the 1967 decision of the Court of Customs and Patent Appeals in *In re Ruschig* forbids basing any narrower claims on disclosure of such a large number of combinations. This claim, aside from being insufficient on its face to justify review, is wrong. As the court of appeals explained, (Pet. App. 18a-19a), the nature of the particular art and the claims at issue determines whether or not a particular case involves a forbidden needle-in-a-haystack situation, like *Ruschig* – a pharmaceutical case involving a disclosure of a broad class of compounds and an ultimately claimed single but wholly undisclosed specific compound. Here, unlike *Ruschig*, the resulting claims are themselves broad ranges, and the disclosures' explanation of the directions of effects from changing variables readily identified each of the ultimately claimed combinations. (Hence, there was possession of the resulting claims at the time of the application.) The difference in facts explains and justifies the difference in result.[5]

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[5] Although petitioners twice assert that the final T10 ranges and aromatics limits were broadened from the original disclosure (Pet. 7, 18), that is plainly wrong: original claim 1 imposed no limitation on T10 or aromatics at all. *See* Pet. App. 58a. Consequently, the claims were actually narrowed. The assertion is also irrelevant, as the only issue is whether the final claims had support in the original disclosure, which does not turn on narrowing or broadening alone. Nor is it relevant whether the '393 application disclosed a "trillion" different compositions (by varying the properties in different combinations). The disclosure, by teaching the direction of

(continued...)

B. The Lower Courts' Claim Construction Does Not Merit Review

The Federal Circuit, in agreement with the district court, construed the patent claims – particularly, the preamble language that petitioners agree serves as a claim limitation – to require a "standard automotive fuel *composition*." Pet. App. 12a (emphasis added); Pet. App. 34a-44a. That construction is intrinsically case-specific. And it properly reflects the application of established principles of claim construction.

This Court has recently confirmed the importance, in construing patent claims as in construing statutes and documents, of interpreting the claim terms so they comport "with [the] patent's internal logic," based on a "necessarily sophisticated analysis of the whole document, required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole." *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996); *id.* at 390 (claims must be construed "in relation to the overall structure of the patent"; construction must "fully comport[] with the specification and claims and so will preserve the patent's internal coherence"). The Federal Circuit relied on the internal evidence of the patent in just that way. Pet. App. 10a-12a.

"An unleaded gasoline suitable for combustion in an automotive engine" is properly understood not to refer to

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[5] (...continued)
alteration of the combination of identified variables, adequately supported all the compositions – specifically, the claimed compositions – as the testimony and evidence amply proved.

aviation gasolines or exorbitantly priced specialized high-purity gasolines made for specialized racing cars, even though such gasolines "*could be burned*" in a regular car (Pet. App. 41a). Rather, the invention targets and the preamble refers to gasolines designed for regular use at expected prices in the typical automobile driven by the millions of drivers who cause pollution. The patent pervasively confirms that narrower focus: for example, the language "automotive engine" points away from aviation fuels; the language "unleaded gasoline" in normal usage "invokes standard automotive fuels, rather than specialized fuels"; the patent's description of "the problem that the[] invention addressed" refers to pollution not from a few racing cars but from the millions of standard automobiles; and the patent's description of the testing that led to the invention refers entirely to "ordinary passenger automobiles." Pet. App. 11a-12a. The language at issue thus bears the meaning discerned and, in context, must take that meaning. *See General Mills, Inc. v. Hunt-Wesson, Inc.*, 103 F.3d 978, 981-82 (Fed. Cir. 1997) (construing term based on problem invention designed to solve); *Applied Materials, Inc. v. Advanced Semiconductor Materials*, 98 F.3d 1563, 1572-73 (Fed. Cir. 1996) (same).

Petitioners accuse the lower courts of adding a limitation to the claims, citing *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 116 (1895). Pet. 20, 22. The courts below, however, did not announce any principle allowing such addition or purport to approve such an addition; to the contrary, the Federal Circuit has expressly followed the rule against adding claim limitations. *See Northern Telecom Limited v. Samsung Electronics Co.*, 215 F.3d 1281, 1290-91 (Fed. Cir. 2000) ("This court has repeatedly and clearly held that it will not read unstated limitations into claim language."); *Markman v. Westview*

Instruments, Inc., 52 F.3d 967, 979-80 (Fed. Cir.1995) (en banc), *aff'd*, 517 U.S. 370 (1996); *E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433-34 (Fed. Cir. 1988); *Renishaw PLC v. Marposs Societa' per Azioni,* 158 F.3d 1243, 1248 (Fed. Cir.1998). In this case, the district court and Federal Circuit both reached their interpretation by the straightforward construction of claim terms undisputedly present, namely, the preamble language. Petitioners' accusation is nothing more than a disagreement with the courts' construction of the key preamble phrases.

Petitioners also accuse the lower courts of violating the principle of *General Elec. Co. v. Jewel Incandescent Lamp Co.*, 326 U.S. 242, 249 (1945), that an old composition cannot be patented based on a new use of the composition (though the new use may be patentable as a method). Pet. 20, 23-24. But the court of appeals could not have been clearer that what was claimed here were certain "compositions" (Pet. App. 10a, 12a) and that these compositions were, in fact, *not* found in the prior art cited by petitioners (Pet. App. 12a). The standard automotive gasolines claimed by this patent were, by petitioners' own evidence, *not* the same compositions as either the aviation or racing fuels that petitioners identified as their sole prior art. Pet. App. 12a. This case thus involves new compositions, not old compositions, and *Jewel Incandescent* is simply inapposite.

Petitioners' complaint, ultimately, is nothing more than that the claimed standard automotive gasoline was never given a chemical-composition *definition*. But lack of such a definition is immaterial to petitioners' legal point based on *Jewel Incandescent*: the fact remains that the patent here claims new, not old, compositions. And such a specific molecular

definition, in this case, would have been superfluous. It was undisputed, and confirmed by petitioners' own evidence, that standard automotive gasoline is a different composition from the relied-on aviation and racing fuels. The fact of the difference was determinative of the novelty issue, without need for further definition of the molecular-makeup specifics of the difference.

CONCLUSION

The petition for a writ of certiorari should be denied.

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CALIFORNIA

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